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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/823,937	03/30/2001	Franz Ott	NHL-SCT-22	7588

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EXAMINER

VINCENT, SEAN E

ART UNIT PAPER NUMBER

1731

DATE MAILED: 03/12/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

## Office Action Summary

Application No.

09/823,937

Applicant(s)

OTT ET AL.

Examiner

Sean E Vincent

Art Unit

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on 19 December 2003.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 40-59 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 40-59 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 30 March 2001 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some \* c) ☐ None of:
- 1) ☒ Certified copies of the priority documents have been received.
  - 2) ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  - 3) ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- |   |   |
|---|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892)                        | 4) <input type="checkbox"/> Interview Summary (PTO-413)                     |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)    | Paper No(s)/Mail Date. _____  |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| Paper No(s)/Mail Date _____   | 6) <input type="checkbox"/> Other: _____                                    |

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## DETAILED ACTION

### *Claim Rejections - 35 USC § 112*

1. The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

2. Claims 41, 42, 45, 46, 49-52 and 55-58 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention. The originally filed disclosure did not provide support for "minimize alkali ions on the contacted surface portion to a surface depth in the range of 150nm to 2000nm".

3. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

4. Claims 48-59 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

5. Regarding claims 48 and 54, the phrase "such as" renders the claim indefinite because it is unclear whether the limitations following the phrase are part of the claimed invention. See MPEP § 2173.05(d).

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***Claim Rejections - 35 USC § 102***

6. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

7. Claims 48-59 are rejected under 35 U.S.C. 102(b) as being clearly anticipated by Terneu et al (US 5221352). The features of applicant's claimed method can be found in the figures and col. 2, lines 5-49; col. 4, lines 57-60 and col. 5, lines 8-17 as well as the examples. Note that the gas claimed has a composition which reads on air and the only examples presented in the applicant's disclosure use air. It is the position of the examiner that the claims read on air.

***Claim Rejections - 35 USC § 103***

8. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

9. This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. 103(a), the examiner presumes that the subject matter of the various claims was commonly owned at the time any inventions covered therein were made absent any evidence to the contrary. Applicant is advised of the obligation under 37 CFR 1.56 to point out the inventor and invention dates of each claim that was not commonly owned at the time a later

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invention was made in order for the examiner to consider the applicability of 35 U.S.C. 103(c) and potential 35 U.S.C. 102(e), (f) or (g) prior art under 35 U.S.C. 103(a).

10. Claims 40-47 are rejected under 35 U.S.C. 103(a) as being unpatentable over Konoko et al (US 3937623) in view of Bienvenue et al (US 4319156).

11. The features of applicant's tube (body) forming can be found in the figures, col. 3, line 61 to col. 4, line 31 and claims 1-4 of Konoko et al. It is the position of the examiner that the claimed regulating method step reads on the controlling disclosed by Konoko et al for forming air and cooling gas supplies into the interior of drawn glass tubes. Konoko et al did not disclose methods of making halogen lamps specifically. Filament insertion and halogen injection steps are very well known in the art as shown by Bienvenue et al (see figures and col. 6, lines 5-30). It would have been obvious to a person of ordinary skill in the art at the time the invention was made to make halogen lamps from the tubes produced by Konoko et al using the finishing steps of Bienvenue et al because the tubes produced by Konoko et al would have been expected to be used in any of a multitude of different undisclosed finishing processes and Bienvenue et al taught that the halogen lamp finishing steps were well known.

12. Konoko et al did not teach glass types or compositions. Bienvenue et al disclosed that aluminosilicate glasses were well known to be used for the manufacture of halogen lamps (see col. 3, lines 9-30). It would have been obvious to a person of ordinary skill in the art at the time the invention was made to use known aluminosilicate glasses in the process of Konoko et al because Bienvenue et al taught that such glasses were well known in the art.

13. With regard to the composition ranges, the selection of any particular proportion within the ranges taught by the reference(s) would appear to involve only routine testing well within the

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scope of the worker in the art, see *In re. Aller et al.*, 105 U.S.P.Q. 233, 42 C.C.P.A. 824. In this case, the claimed ranges are broad enough to read on many well known glasses including the specific glass disclosed in *Bienvenue et al.*

14. With regard to the alkali minimization to surface depths of 150nm to 2000nm, it is the position of the examiner that since applicant's claims read on air and applicant's examples use air, air as applied to the tube interior of *Konoko et al* would inherently satisfy the limitation of providing a stream of gas having a "configured" oxygen content.

#### ***Response to Arguments***

15. Applicant's arguments filed December 19, 2003 have been fully considered but they are not persuasive.

16. In response to the argument that the prior art does not teach "providing a stream of gas to contact a portion of a surface of said glass body having an oxygen content configured to minimize alkali ions on the contacted surface portion to a surface depth sufficient to minimize reactivity of the contacted surface portion.", the examiner disagrees. All of applicant's claims have similar limitations, but the claims still read on the use of air as the stream of gas.

Furthermore, pages 25 and 27 of applicant's specification repeatedly demonstrate that the stream of gas is meant to be air. Since the gas claimed is identical to the gas of the prior art and the glass forming steps are the same, it would have been obvious to a person of ordinary skill in the art at the time the invention was made to expect the results to be the same.

17. In response to applicant's arguments against the references individually, one cannot show nonobviousness by attacking references individually where the rejections are based on

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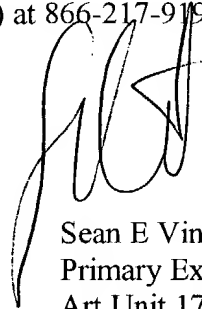
combinations of references. See *In re Keller*, 642 F.2d 413, 208 USPQ 871 (CCPA 1981); *In re Merck & Co.*, 800 F.2d 1091, 231 USPQ 375 (Fed. Cir. 1986). Applicant has not explained why the combination of Konoko et al and Bienvenue et al is improper.

### ***Conclusion***

18. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Sean E Vincent whose telephone number is (571) 272-1194. The examiner can normally be reached on M - F (8:30 - 6:00).

19. If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Steven P Griffin can be reached on (571) 272-1189. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

20. Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).



Sean E Vincent  
Primary Examiner  
Art Unit 1731

S Vincent